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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,121	06/22/2001	Peter J. Dronzek JR.	559-018	8226

7590 02/20/2003

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EXAMINER

CARTER, MONICA SMITH

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 02/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/888,121

Applicant(s)

DRONZEK ET AL.

Examiner

Monica S. Carter

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3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 18-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 31-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly submitted claims 18-30 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The claims are directed to a hollow plastic container having a label. The previous claims of record (claims 1-17) are directed to the subcombination of the label only. It is noted that claims 14 and 15 are a mere recitation of a container and, therefore, those claims were included in the previous rejections.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-30 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-17 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda et al. ('754).

Yasuda et al. disclose an in-mold label/ article of manufacture with a coupon comprising at least one removable section (5- coupon which, inherently, receives printing) and at least one permanent section (sections located on the opposite surfaces of the adhesive 3 in figure 1), the removable section being defined by two or more discontinuities (6) spaced apart on an edge of the label; the discontinuities being located so that a line which is extended to connect the discontinuities is substantially perpendicular to the axis of orientation (as seen in figure 1, a line connecting the notches 6 provides a line that is perpendicular to the axis of orientation, wherein the axis of orientation is indicated by the arrow located above the upper dashed line of 4b).

Yasuda et al. disclose the claimed invention except for the particular material of the label as claimed (claims 1-17 and 31-34). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any type of material (i.e. polymeric film that is uniaxially oriented in line with the direction of tear by stretching in one direction only, opaque or clear virgin olefin homopolymer, etc.) as necessitated by the end user, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416. Furthermore, the uniaxially oriented, polymeric film being in line with the direction of tear by stretching in one direction only does not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the

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manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113)

Regarding claims 2 and 8, it would have been an obvious matter of design choice to provide the label with any desired dimensions, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 7 and 33, see the above rejections. Further, Yasuda et al. disclose the adhesive layer (3) being continuously applied to both the permanent and removable sections of the label (see figure 2 and col. 2, lines 57-65).

### ***Response to Arguments***

4. Applicant's arguments filed December 9 2002 have been fully considered but they are not persuasive.

Applicant argues that Yasuda et al. disclose a biaxially-oriented film. The biaxially stretched film is prepared by first stretching in the machine direction then stretching in the transverse direction. Applicant argues that this is in contrast to the present invention. The examiner maintains that the material selected by the user for the label would determine the particular properties associated with the label. Furthermore, how the material is prepared (stretching in one direction only)

does not structurally limit the invention. The patentability of a product does not depend on its method of production.

Applicant argues that Yasuda et al. fail to disclose the abhesive layer is always put down before a continuous layer of adhesive is put down overall. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, the examiner is not clear what is meant by "abhesive layer", since "abhesive" is not the proper spelling of "adhesive". As seen in figure 2, adhesive is applied to both the permanent sections and the removable section of the label. Yasuda et al. disclose that zone 4 is a less adhesive zone and that part 4a is free of adhesive for forming a non-adhesive stripping starting part. Applicant has failed to claim that the adhesive is continuous across the surfaces in their entirety.

Note: Remarks with respect to claims 18-30 are moot in view of the above election by original representation.

For the reasons as set forth above, the rejections are maintained.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

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See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

*Monica S. Carter*  
MONICA CARTER  
PATENT EXAMINER

February 19, 2003